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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,583	05/29/2002	Lutz Weber	FMW-XX-PCT-US	6873
28862	7590	09/30/2005	EXAMINER	
HUDAK, SHUNK & FARINE, CO., L.P.A. 2020 FRONT STREET SUITE 307 CUYAHOGA FALLS, OH 44221			NAGPAUL, JYOTI	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*h*

<b>Office Action Summary</b>	<b>Application No.</b> 10/070,583	<b>Applicant(s)</b> WEBER, LUTZ	
	<b>Examiner</b> Jyoti Nagpaul	<b>Art Unit</b> 1743	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*EL*

### DETAILED ACTION

Amendment filed on July 11, 2005 is acknowledged. Claims 1-19 are pending.

#### ***Response to Amendment***

Claims 1-2,8-14 and 16-19 are rejected as being anticipated by Burbaum (US 6274088) has been *maintained* in light of applicant's arguments.

Claims 3-7 and 15 are rejected as being unpatentable over Burbaum in view of Bevirt (US 6063579) has been *maintained* in light of applicant's arguments.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-2,8-14 and 16-19** are rejected under 35 U.S.C. 102(b) as being anticipated by Burbaum (US 6274088).

Burbaum discloses an apparatus for high throughput parallel separation and filtration for biological fluids using microtiter plates. The apparatus comprises one receiving device (120) for receiving the substance support (140). The receiving device comprises a level device/compression plate (140) that at least partially levels out the substance support before or while or before and while the basic operation is carried out, by subjecting the plate to pressure force or attraction force or pressure force and attraction force toward a planar area of support. (See Figure 1) The leveling device (140) comprises a negative pressure device/pins (161) for pressing or attracting or

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pressing and attracting the substance support onto the area of support onto the area of support. The leveling device comprises a pressure plate (110) capable of being subjected to force, for pressing the substance support onto the support surface (120). The pressure plate (110) is capable of being subjected to mechanical force/tightening of pins by nuts (163 and 164) from above. The pressure plate (110) is also capable of being subjected to electro-mechanical force. The pressure pins (361 and 362) are distributed on the pressure plate in such a way that they are inserted fully home on wall areas between two reaction vessels of the substance support. The pressure plate (110) exhibits at least one recess (513 and 523) in such a manner that the reaction vessels are freely accessible for carrying out at least one of the basic operations. (Col. 4, Lines 60-62) At least one recess is designed as holes arranged on the pressure plate in the same modular size as the reaction vessels on the substance support. (See Figure 3 and Col. 3, Lines 60-62) The support plate or vacuum plate or support plate exhibits a large number of measuring channels/96 wells for receiving or connecting or receiving and connecting detection elements, which are arranged in the same modular sizes the reaction vessels on the substance support. (Col. 3, Lines 60-63)

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 3-7 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burbaum in view of Bevirt (US 6063579).

Refer above for the teachings of Burbaum.

Burbaum fails to teach a vacuum channel connected to the area of support and connected to a negative pressure source. Burbaum also fails to teach the vacuum channel is arranged in a planar support plate in such a manner that the support plate exhibits multiple suction grooves on a support side turned toward the substance support where the support side of the support plate forms the support surface. Burbaum also fails to teach a vacuum plate is arranged between the substance support and support side of the support plate, whereby a top side of the vacuum plate forms the support surface. Burbaum also fails to teach the vacuum plate exhibits at least one porous layer for the homogeneous attraction of the substance support.

Bevirt discloses microtiter plate apparatus for filtration and separation of biological fluids. The apparatus comprises of a vacuum channel (62) connected to the area of support (4) and connected to a negative pressure source/vacuum port (20) where the vacuum channel (62) is arranged in a planar support plate (12) in such a

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manner that the support plate exhibits multiple suction grooves on a support side turned toward the substance support where the support side of the support plate forms the support surface. (See Claim 1) The vacuum plate (2 or 30) is arranged between the substance support and support side of the support plate, whereby a top side of the vacuum plate forms the support surface. (See Figure 1) The vacuum plate (12 or 30) exhibits at least one porous layer for the homogeneous attraction of the substance support. (Col. 4, Lines 61-63)

It would have been obvious to one of the ordinary skill in the art to modify the device of Burbaum such that the support surface comprises of a vacuum channel connected to the area of support and connected to a negative pressure source/vacuum port where the vacuum channel is arranged in a planar support plate in such a manner that the support plate exhibits multiple suction grooves on a support side turned toward the substance support and also where the support side of the support plate forms the support surface in order to decrease cross-contamination between wells and increase alignment of the plates on the support surface.

#### ***Response to Arguments***

4. Applicant's arguments filed July 11, 2005 have been fully considered but they are not persuasive.

Applicant argues his claimed invention is different from that of Burbaum as Burbaum does not teach performing the functions recited in the preamble of claim 1. Examiner would point out that the structure of the apparatus of Burbaum is identical to that recited in the body of applicant's claim. Clearly it would be capable of performing

those same functions as it is identical. Examiner would also point out that those recitations are of the intended use of the device. If the prior art device is capable of performing those intended uses, then the prior art anticipates a claim to an apparatus intended to perform those functions. It is inherent that the leveling device (140) of Burbaum is adjusted to the requirements of a workstation of the screening and/or synthesis device, so that at least one basic operation can be carried out in order to enable the device. With respect to "a relatively small volume between the basic area 5 and planar support are 8" as stated in the applicant's remarks, applicant is not claiming this.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

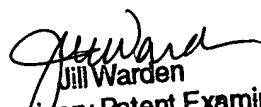
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700